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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HOWARD JUSTIN GLASER and DANIEL EDWARD HOUSE

Appeal No. 2004-1619
Application No. 09/162,685¹

ON BRIEF

Before BARRETT, DIXON and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-34, which are all of the claims pending in this application.

We reverse.

BACKGROUND

Appellants' invention is directed to programming development environments performed on computers by which developers may keep track of element mappings from the forms generated by the developmental tool to HTML pages. By displaying relationships

¹ Application for patent filed September 29, 1998.

between elements mapped from a form to an HTML page, any invalid or incomplete mapping is indicated which can be modified by the user by selecting the cell corresponding to the invalid element (specification, page 34).

Representative independent claim 1 is reproduced below:

1. A method of displaying a relationship between an HTML file and an element from a form, wherein the element is in an HTML page, comprising:

reading information from a project file, the information comprising a relationship between the element that has been transferred from the form to the HTML page and the HTML file associated with the HTML page;

processing the information to map the element from the form to the HTML file; and

displaying the mapping on a graphical user interface that indicates the relationship between the element, the form, and the HTML file.

The Examiner relies on the following references:

Arora et al. (Arora) 5,911,145 Jun. 8, 1999
(filed Jul. 29, 1996)

[illegible]

HTMLEd, program by "Internet Software Technologies," Apr. 26, 1997, from <<http://www.winsite.com>>, downloaded Jun. 27, 2003, screenshots pp. 1-9.

Namo WebEditor (Namo), program by "Namo Interactive, Inc.," Aug. 19, 1997, from <<http://www.winsite.com>>, downloaded Jun. 27, 2003, screenshots pp. 1-8.

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Claims 1, 2, 4, 11-13, 15, 22-24, 26, 33 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over HTMLed.

Claims 3, 5, 14, 16, 25 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over HTMLed and Namu.

Claims 6-8, 17-19 and 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over HTMLed and Arora.

Claims 9, 10, 20, 21, 31 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over HTMLed and Lisle.

We make reference to the answer (Paper No. 19, mailed January 12, 2004) for the Examiner's reasoning and to the appeal brief (Paper No. 18, filed November 8, 2003) and to the reply brief (Paper No. 20, filed March 11, 2004) for Appellants' arguments thereagainst.

OPINION

The focus of Appellants' arguments is that HTMLed fails to teach the claimed relationship between the element, the form that the element was transferred from, and an HTML file that the element was transferred to (brief, page 6). Appellants point out that based on the relationship between the element and a particular HTML file, the claims recite that a mapping from the element in the form to the HTML file is obtained and displayed which allows the user to identify the element, the form and the HTML file (id.). Emphasizing on the distinction between the

terms "form" in the claims and "HTML form" used in HTMLed, Appellants argue that HTMLed merely shows an HTML Form and a list of elements that can be placed into the form (brief, pages 7 & 8; reply brief, pages 2-5). Additionally, Appellants argue that since HTMLed fails to teach or suggest the forms that the element was transferred from or a mapping of form elements, there is no reason for the skilled artisan to consider such mapping or the benefit displaying it (brief, page 9; reply brief, page 5).

In response to Appellant's arguments, the Examiner asserts that the claimed mapping is merely some kind of relationship between form elements and a form, shown by HTMLed as the position of elements "Radio Button" and "submit" (answer, paragraph linking pages 12 & 13). Furthermore, to support the modification, the Examiner argues that containing the displayed source code of the form within an HTML file suggests mapping between the elements, the form and the file to the skilled artisan (answer, page 13).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). The Examiner must not only identify the elements in the prior art, but also show "some objective teaching in the prior art or that knowledge generally available

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to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000), citing B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996). Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

Upon a review of the applied prior art, we disagree with the Examiner that the claimed relationship between the elements, the form and the HTML file is disclosed or suggested by the prior art. What a reference teaches is a question of fact. In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (citing In re Beattie, 974 F.2d 1309, 1311, 24 USPQ2d 1040, 1041 (Fed. Cir. 1992)). Here the Examiner ignores the claim requirement that the mapping should indicate the relationship between a form, the element in an HTML page transferred from the form, and the HTML file associated with the page. As pointed out by Appellants (reply brief, starting at page 4), the closest HTMLed comes to suggesting the claims is merely a link between an

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element selected to be part of the HTML Form and the HTML source code for the Form, displayed as the "Form designer: Source" and the "Form Designer" windows on page 9 of HTMLed. However, this depiction of the elements of an HTML Form contains no suggestion that any mapping is displayed to indicate the relationship between the form an element is transferred from, the element and the HTML file, as provided for in Appellants' claim 1.

Therefore, we remain unconvinced by the Examiner that the element description listing in the "Form designer: Source" window of the drag-n-drop objects of an HTML form in the "Form Designer" window, sufficiently suggests a mapping between the windows. Accordingly, based on the Examiner's failure to establish a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of claims 1, 2, 4, 11-13, 15, 22-24, 26, 33 and 34 over HTMLed cannot be sustained.

With respect to the rejection of the remaining claims, the Examiner further relies on Namu, Arora and Lisle. However, none of these references, alone or in combination with HTMLed, overcomes the deficiencies discussed above with respect to claim 1. Therefore, we do not sustain the 35 U.S.C. § 103 rejection of claims 3, 5, 14, 16, 25 and 27 over HTMLed and Namu, claims 6-8, 17-19 and 28-30 over HTMLed and Arora and claims 9, 10, 20, 21, 31 and 32 over HTMLed and Lisle.


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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-34 under 35 U.S.C. § 103 is reversed.

REVERSED


LEE E. BARRETT
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge

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) INTERFERENCES

MAHSHID D. SAADAT
MAHSHID D. SAADAT
Administrative Patent Judge

MDS/ki

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Gates & Cooper, LLP
Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, CA 90045